THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAOZHENG LU, PAUL C. KEMPTER,
and WILLIAM A. FEININGER

Appeal No. 2006-1636
Application 09/076,517

ON BRIEF

Before THOMAS, RUGGIERO, and HOMERE, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 70, 71 and 159.

Representative independent claim 70 is reproduced below:

70. An audience rating system for digital television, comprising the steps of:

extracting at least one identification code for at least one digital stream of a first channel, from a control stream of a multiplexed digital transmission, when reception of the first channel by a receiver begins;

recording at least one identification code extracted and thus time reception of the first channel begins;

extracting at least one identification code for at least one digital stream of any subsequent channel, from the control stream of the multiplexed digital transmission, when reception of the subsequent channel by the receiver begins; and

recording at least one identification code extracted and the time reception of the subsequent channel begins.

The following reference is relied on by the examiner:

Aras et al. (Aras)	5,872,588	Feb. 16, 1999 (filed Dec. 6, 1995)

Claims 70 and 71 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Aras. Claim 159 stands rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Aras alone.[1]

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief filed on April 13, 2005 and the reply brief filed on January 9, 2006 for appellants' positions, and to the answer mailed on November 2, 2005 for the examiner's positions.

OPINION

For the reasons set forth by the examiner, as expanded upon here, we sustain the rejections of the claims on appeal under 35 U.S.C. § 102 and 35 U.S.C. § 103. As set forth in footnote 4 at the bottom of page 30 of the principal brief on appeal, for purposes of rendering a decision under the Aras rejections of record, appellants indicate that claims 70, 71 and 159 fall together with respect to the rejections based on Aras. More specifically, appellants state that the patentability of claims 71 and 159 over Aras is not argued separately from the patentability of claim 70 rejected over that reference.

[1] As indicated at pages 7 through 9 of the answer, the examiner has withdrawn an outstanding rejection of the claims on appeal under the written description portion of the first paragraph of 35 U.S.C. § 112.

As background to the present appeal, appellants have indicated at pages 2 through 6 of the principal brief on appeal that the present claims on appeal were copied from another U.S. patent for which appellants requested reexamination. As stated at page 3 of the principal brief on appeal, "independent claim 1 of the '299 Patent was copied into this application as claims 70, 71 and 159, which now form the subject matter of this appeal." In fact, the subject matter of independent claim 70 on appeal in this application is broader than the recitation of corresponding claim 1 by the deletion of the features now recited in dependent claims 71 and 159, dependent claims of claim 70.

Since the present applicants are the requestors in the noted reexamination bearing Control No. 90/007,057 of the U.S. patent 5,974,229, appellants have stated at the bottom of page 3 of the Request for Reexamination that "since the '517 application predates the '299 Patent, if claim 1 of the '299 Patent is unpatentable in the '517 application [that is, the present application on appeal before us] it is likewise unpatentable in the later filed '299 Patent." This is not necessarily true since the present claim 70 on appeal is a broader version of claim 1 in the noted patent. What is true, however, is since the present independent claim 70 on appeal is broader

than claim 1 in the noted patent, if the subject matter of claim 1 of the noted patent is unpatentable to the patentee, then it is unpatentable in the present appeal. Since the examiner has essentially found that to be the case in the reexamination proceedings to which the present appellants have been duly notified since they are the requestor in the reexamination proceedings, by simple logic, these present claims 70, 71 and 159 are unpatentable in the present appeal. This is true since the examiner in the present appeal has relied upon the same prior art as presented by the present appellants in the reexamination proceeding since they presented the same Aras patent as relied upon here to the examiner in the reexamination proceeding to substantiate a conclusion of unpatentability.

Based on the nature of the arguments presented here, it is noted that appellants appear to be taking inconsistent positions with respect to the patentability of the present claims on appeal to that which they have taken in urging the examiner to find a substantial question of patentability in the reexamination proceeding request. Page 4 of the Request for Reexamination indicates that the present appellants take the view "that the control stream/data stream distinction is immaterial to the patentability question." In fact appellants, especially in the reply brief in this appeal, have taken a

contrary position. We are therefore somewhat perplexed at appellants' statement at the bottom of page 4 of the Request for Reexamination that they are maintaining the appeal in the present application pending the outcome of the reexamination proceeding.

With this general understanding in mind, we agree with the examiner's rejection of the present claims on appeal with respect to representative independent claim 70 on appeal as set forth at pages 4 and 5 of the answer as well as the examiner's responsive arguments at pages 10 through 12 of the answer that address the arguments at pages 30 through 37 of the principal brief on appeal.

The examiner's positions in this appeal with respect to the patentability of independent claim 70 on appeal herein are generally similar to that which has been set forth by the examiner in the reexamination proceeding as set forth in the Office action mailed to the patentee and the present appellants as the requestor of the reexamination on April 21, 2005. The responsive amendment to this Office action filed by the patentee on June 20, 2005 cancelled certain claims and heavily amended the subject matter of corresponding claim 1 to the patentee. The examiner accepted the proposed amendment with minor additional amendments thereafter. With

mind, appellants in this appeal still persist in pursuing patentability of broader independent claim 70 on appeal herein than was presented originally in the reexamination proceeding.

The only feature of present independent claim 70 on appeal argued by appellants is the language "a control stream." For proper context of understanding of this stream, it is actually "a control stream of a multiplexed digital transmission." Thus, the control stream is a part of another, larger digital transmission stream.

The bulk of the arguments presented by appellants in the noted pages in the principal brief on appeal relate to corresponding discussions in the specification as filed which are not recited in independent claim 70 on appeal with a focus upon the view, in effect, that because the Aras patent does not teach the disclosed program guide as a manner of defining what the claim "a control stream" comprises, the claims are patentable to appellants. This view is more forcefully advocated in the reply brief.

We do not agree with these views set forth repeatedly in various forms in the brief and reply brief. The claims measure the invention. SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985)(en banc). During prosecution before the USPTO, claims are to be

given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969).

Since appellants have had an ample opportunity to amend the present claims in this appeal during prosecution to include the feature of a program guide as comprising the claimed "a control stream," appellants' arguments invite us to, in effect, read limitations from the specification into claim 70 rather than by actually amending the claim themselves. Even as recited in the present claims on appeal, the claim "a control stream" is a part of a larger data stream of multiplexed information. The same is true according to the so-called content coding and the AVI signals in Aras.

In addition to what the examiner relies upon in Aras as justifying a basis of unpatentability of the present claims on appeal, we note the showings in Figures 2, 3, 6J and Figures 9-17 generally with the focus upon the features of the control signal decoding in Figures 15 and 16 in Aras. At least with respect to the Figure 3 showing in Aras, the content coding of the AVI signals may be included in a larger data stream of data which is also

generally depicted in Figure 2. Figures 6J indicates that a command is received by the unit in the home station for decoding. This is also particularly shown in Figures 15 and 16 of Aras.

Moreover, the examiner's reliance upon the paragraph bridging columns 6 and 7 of Aras is significant. Among the so-called in the art "On-Demand" TV programs that inherently require control signals to be sent through a set top box or the like of a corresponding television at a reception station, the examiner's additional reliance upon the teaching of using MPEG coding of some form requires the additional transmission of coding data and control data of some type to indicate to the receiving device that such a type of coding must be decoded. Significantly as well, the ability of the system of Aras to use encrypted signals requires the transmission of coding signals or control signals of some form to indicate that to a reception box at a home station. Even more significantly is the teaching at lines 1 through 5 of column 7 that in addition to these signals, so-called "access control" signals are also capable of being sent to the home station as well. Thus, to the extent the brief and reply brief attempt to persuade us that the data stream that appears to be present in Aras does not include a control stream, this is not only inconsistent with appellants' original positions provoking the

reexamination proceeding, it also contravenes the actual teachings in the reference. The data streams in Aras include control information in the same manner as appellants' recitation of the control stream is recited in independent claim 70 on appeal to be a part of a larger multiplexed digital transmission.

In view of the foregoing, the decision of the examiner rejecting various claims on appeal under 35 U.S.C. § 102 and § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

James D. Thomas)
Administrative Patent Judge)
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Joseph F. Ruggiero) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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